

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
Oct. 22, 2004

Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Medtronic Physio-Control Corp.

v.

Osypka Medical, Inc.

Opposition No. 91124380
to application Serial No. 76142735
filed on October 6, 2000

Cindy L. Caditz of Christensen O'Connor Johnson & Kindness
PLLC for Medtronic Physio-Control Corp.

Rob G. Leach of Charmasson & Buchaca for Osypka Medical,
Inc.

Before Hohein, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark PHYSIOCOM (in typed form) for "medical
instruments, namely, heart measuring, monitoring, diagnostic
and data communication equipment, including parts thereof,
operating software and operating firmware," in Class 10.¹

¹ Serial No. 76142735, filed October 6, 2000. The application is
based on applicant's asserted intent to use the mark in commerce.
Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Opposer filed a timely notice of opposition to registration of applicant's mark. The pleaded grounds of opposition are:

(i) a claim under Trademark Act Section 2(d), 15 U.S.C. §1052(d), that applicant's mark, as applied to applicant's goods, is likely to cause confusion vis-à-vis opposer's previously-used and registered marks PHYSIO,² PHYSIO-CONTROL³ and PHYSIO CONTROL⁴ and opposer's previously-used trade names PHYSIO-CONTROL and PHYSIO CONTROL, all of which are used by opposer in connection with medical instruments, namely, defibrillators and accessories for defibrillators, monitors and other cardiac care equipment;

(ii) a claim under Trademark Act Section 2(a), 15 U.S.C. §1052(a), that applicant's mark falsely suggests a connection between opposer and applicant; and

(iii) a claim under Trademark Act Section 43(c), 15 U.S.C. §1125(c), that applicant's use of the applied-for mark is likely to dilute the distinctiveness of opposer's famous trademarks PHYSIO-CONTROL and PHYSIO CONTROL.

Applicant filed an answer, by which it denies the salient allegations of the notice of opposition and asserts

² Registration No. 1427363.

³ Registration Nos. 0933932, 1035260, 1135675, 1225724, and 1414815.

⁴ Registration No. 1436339.

various affirmative defenses which essentially are merely further denials of opposer's likelihood of confusion claim.

At trial, opposer submitted the June 23, 2003 testimony deposition of Rene Mitchell, opposer's Director of Medical Informatics, together with the exhibits thereto. Opposer also made of record (via notice of reliance filed on June 30, 2003) status and title copies of its seven pleaded registrations, which show that all of the registrations are extant and are owned by opposer. To summarize, five of the registrations are of the mark PHYSIO-CONTROL (in typed form), for goods which include, in pertinent part, "electrocardiograph recorders, patient monitoring oscilloscope systems, heart monitoring and defibrillation systems," "combination heart monitor, heart signal recorder and defibrillator units," "accessories for combination heart monitor and defibrillator units," "electronic operating room and bedside monitors for use in monitoring ECG signal, heart rate, pulse, blood pressure, blood oxygen saturation, temperature or carbon dioxide of a patient," and "automatic and semiautomatic defibrillators," all in Class 10. Another of the registrations is of the mark PHYSIO CONTROL (in typed form) for "electrocardiograph recorders; patient monitoring oscilloscope systems; heart monitoring and defibrillation systems," in Class 10. The final registration is of the

mark PHYSIO (in typed form) for "ECG patient cables and replacement patient lead wires," in Class 10.

Applicant submitted no evidence at trial. Opposer filed a brief on the case, but applicant did not. No oral hearing was requested.

Opposer has proved that its pleaded registrations are subsisting and owned by opposer. In view thereof, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We turn next to opposer's pleaded Section 2(d) ground of opposition. Because opposer has proved that its pleaded registrations are subsisting and owned by opposer, Section 2(d) priority is not an issue in this case as to the marks and goods covered by those registrations. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on

these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering first the parties' goods, we note that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

In this case, we find that the goods identified in applicant's application, i.e., "medical instruments, namely, heart measuring, monitoring, diagnostic and data

communication equipment, including parts thereof, operating software and operating firmware," are legally identical to, complementary to or otherwise closely related to certain of the goods identified in opposer's PHYSIO, PHYSIO-CONTROL, and PHYSIO CONTROL registrations, i.e., "electrocardiograph recorders, patient monitoring oscilloscope systems, heart monitoring and defibrillation systems," "combination heart monitor, heart signal recorder and defibrillator units," "electronic operating room and bedside monitors for use in monitoring ECG signal, heart rate, pulse...", "accessories for combination heart monitor and defibrillator units," and "ECG patient cables and replacement patient lead wires." Both parties' goods comprise or include heart monitoring equipment and accessories therefor. The respective goods are sufficiently similar or related that confusion as to source, sponsorship or affiliation is likely to result if the goods are or were to be marketed under similar marks.

In view of the legal identity of, and/or close relationship between, the parties' respective goods, we find as well that the trade channels and the classes of purchasers for the respective goods are identical and/or overlapping. Neither applicant's nor opposer's respective identifications of goods includes any limitation as to trade channels or classes of purchasers, and we therefore presume that the goods are or will be marketed in all normal trade

channels and to all normal classes of purchasers for such goods. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). These would include the hospital, out-of-hospital, commercial and consumer trade channels and classes of purchasers in which and to whom opposer currently markets its goods. (Mitchell Depo., pp. 37-39.)

In short, we find that the parties' respective goods, as identified in applicant's application and in opposer's registrations, are legally identical and/or closely related, and that the respective goods are or would be marketed in the same trade channels and to the same classes of purchasers. These facts weigh significantly in favor of a finding of likelihood of confusion.

Also weighing heavily in favor of a finding of likelihood of confusion is the fame of opposer's PHYSIO-CONTROL mark. The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of opposer's mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

Opposer currently enjoys a 47% to 48% share of the market for external defibrillation products. (Mitchell Depo., p. 102.) Opposer's United States sales of its PHYSIO-CONTROL products from 1975 through 2002 exceed \$2.5 billion. (Mitchell Depo., pp. 120-122; Exh. No. 1541.) Opposer currently spends in excess of \$850,000 per year in advertising its PHYSIO-CONTROL products in the United States, and has spent over \$500 million in promoting and marketing its products throughout the world since 1992. (Mitchell Depo., 121-22; Exh. No. 1542.) Opposer and its products have been the subject of numerous articles published in newspapers, business journals and elsewhere. (Mitchell Depo., pp. 103-120.) Based on this evidence, we find that opposer's PHYSIO-CONTROL mark is a famous mark for purposes of the fifth *du Pont* evidentiary factor, and that

this fame must be accorded significant, indeed dominant weight in our likelihood of confusion analysis. *See Bose Corp. v. QSC Audio Products Inc., supra.*

We next must determine whether applicant's mark and opposer's marks, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a

finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find that applicant's PHYSIOCOM mark is similar to each of opposer's registered PHYSIO, PHYSIO-CONTROL and PHYSIO CONTROL marks. In terms of appearance, sound and connotation, the parties' marks are identical to the extent that they all consist of or prominently feature the designation PHYSIO. Although this term (the prefix in the word "physiological") might be deemed to be somewhat suggestive as applied to medical instruments, we find that it nonetheless is the dominant feature in each of the respective marks. It is the whole of opposer's PHYSIO mark, and it appears first and would be pronounced first in each of the other marks at issue. *See, e.g., Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Moreover, there is no evidence (under the sixth *du Pont* factor) that PHYSIO is a term which is commonly used by others in trademarks for such goods; indeed, on this record, it appears that opposer is the only user of the term in connection with such goods.

Viewing the marks in their entirety, we find that applicant's mark and opposer's marks create similar overall commercial impressions. The marks are not identical,

inasmuch as applicant's mark (but not opposer's marks) has the suffix -COM, and two of opposer's marks (but not applicant's mark) include the word CONTROL. However, we find that these points of dissimilarity in the marks are outweighed by the presence in each of the marks of the word PHYSIO, and by the similar overall constructions of the marks. Applicant's PHYSIOCOM mark incorporates opposer's registered PHYSIO mark in its entirety. Applicant's PHYSIOCOM mark and opposer's PHYSIO-CONTROL and PHYSIO CONTROL marks have similar constructions, i.e., the term PHYSIO followed by a second, somewhat suggestive, designation. Moreover, both of those second designations begin with the letters "CO-." Purchasers familiar with opposer's PHYSIO, PHYSIO-CONTROL and PHYSIO CONTROL marks as used on opposer's goods are likely to assume that similar (or identical) goods bearing a PHYSIOCOM mark originate from, or are approved or sponsored by, opposer, or that some other source affiliation exists.

The final *du Pont* factor to be considered is the conditions of purchase. It appears from the record that opposer's goods are somewhat expensive (ranging in price from \$1600 to \$25,000), and that they often would be purchased by somewhat careful and knowledgeable purchasers (such as hospital purchasing departments). However, we find that even such knowledgeable purchasers are likely to be

confused when they encounter applicant's mark in use on goods which are similar or identical to the goods on which opposer's famous marks are used. Moreover, the evidence also shows that purchasers of these goods can include those who are not especially knowledgeable, and even general consumers. On balance, we find that this *du Pont* factor weighs in applicant's favor, but only slightly.

Having considered the evidence of record as to all of the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. Given the legally identical and/or similar nature of the parties' respective goods, trade channels and classes of purchasers, we find that applicant's mark is sufficiently similar to opposer's marks that confusion is likely. This is so notwithstanding the relative sophistication of some purchasers. When we factor in the fame of opposer's marks and the dominant weight such fame must be accorded in our analysis, we have no doubt that a likelihood of confusion exists. We hasten to add that even if we had any such doubt, we would have to resolve it against applicant. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio) Inc.*, *supra*.

In summary, we find that opposer has established its

standing to oppose and its Section 2(d) ground of opposition.⁵

Decision: The opposition is sustained.

⁵ In view of our decision sustaining opposer's Section 2(d) ground of opposition, we need not and do not decide opposer's Section 2(a) and Section 43(c) grounds of opposition, nor do we make any findings with respect thereto.